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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,052	09/26/2003	Richard H. Selinfreund	VII-114.4B(US)	7180
909	7590	09/20/2004	EXAMINER	
PILLSBURY WINTHROP, LLP			ANGEBRANDT, MARTIN J	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	

1756

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/672,052	Applicant(s) SELINFREUND ET AL.	
	Examiner Martin J Angebranndt	Art Unit 1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/2/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of claim 2 recites "a compound" and the body of the claims includes a description of a compound and a physical structure. For the purposes of evaluating prior art, the contacting with a structure is considered an intended use.

The groups recited for X and Y do not include clearly some of the groups exemplified in figure 1. The applicant may wish to correct this with active recitations.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Chandra et al., Studies on some new phenothiazines”, Can. J. Chem., Vol. 45, pp 761-767 (1967).

See the 3-Chloro-7-ethoxy, 3-bromo-7-methoxy and 3-Bromo-7-ethoxy phenothiazines described in table IV on page 765 and table II on page 763.

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being fully anticipated by Selinfreund et al. 2004/0004922.

See figure 6

7. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Saraf et al., Recent advances in the synthesis of phenothiazines”, Heterocycles, Vol. 26(1) pp. 239-273.

See the 3-Chloro-7-ethoxy, 3-bromo-7-methoxy and 3-Bromo-7-ethoxy phenothiazines described in table I on page 243. See compound 39, where $R=R_2=$ Hydrogen and R_1 is NO_2 or Cl on page 251. See compound 47, where R is NO_2 or CF_3 on page 252. See the 1,3-dinitro-7-ethoxy, 1-nitro-3-chloro-7-ethoxy, 3-nitro-7-ethoxy, 1,7-dinitro-3-methoxy, 1,7-dinitro-3-ethoxy, and other phenothiazines described in table on page 257 and 258. See also compounds 89 and 90 on page 263

8. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Aramaki et al. JP 08-122836.

See formula 1 and phenothiazine compounds listed on pages 4 and 6.

9. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Kubo et al. JP 01-228976.

See formula 1 and phenothiazine compounds listed on pages 4 and 5.

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10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Daneke et al. , 'Addition von Nucleophilien an in situ erzeugtes Phenoazathionium – Kation', Leibigs Ann. Chem., Vol 740, pp. 52-62 (1970) and Cauquil, et al. Bull. Soc. Chim. France (1955), pp. 1061-1075 teach various phenothiazines and their synthesis.

Morrison & Boyd, "Organic Chemistry", pp. 360(1973) teaches electron releasing and electron donating moieties.

Rollhaus et al. '772 teach the use of methylene blue (a phenothiazine) in the copy prevention of optical recording media.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J Angebranndt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Martin J Angebranndt

9/15/04

MARTIN ANGEBRANNDT
PRIMARY EXAMINER
GROUP 1100

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